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10/688,614	10/17/2003	Kelcy L. Warren	ETG:1003RCE	2439
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BORISSOV, IGOR N				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/688,614

**Applicant(s)**

WARREN ET AL.

**Examiner**

IGOR BORISSOV

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

Amendment received on 07/06/2009 is acknowledged and entered.

Claims 9, 14-21, and 23 have been withdrawn. Claim 22 has been amended.

Claims 1-23 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 22 is written in "single means claim" format since they recite only one element to do all the functions recited.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

MPEP 2164.08(a)

The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language.

Claim 22 is drawn to any of the listed devices, regardless of construct, that perform the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived".

See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus, claim 22 yields "device" that achieve a result without defining what will do so.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 10-13 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Headings et al. (US 2002/0144283 A1) in view of White (US 2004/0103026 A1).**

Headings et al. (Headings) teaches a method and system providing commercials to an audience, comprising:

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Claims 1 and 22,

presenting a user with a publicly accessible website for managing a plurality of versions of commercials over the Internet (Fig. 1; 0039; 0029-0032), wherein the user is authorized to access features associated with the website by inputting at least one of a user name and a password (accessing a website with the user name and a password is old and well known practice for the benefit of security);

in response to determining that the user is authorized to access the features associated with the website, presenting a plurality of advertisement campaigns to the user on the website (providing available/older rollouts for selection 0032; 0040), wherein:

the plurality of advertisement campaigns includes at least one customizable advertisement campaign that is selectable by the user (0030, 0032);

the at least one customizable advertisement campaign includes a plurality of media slots, each media slot is configured to receive one or more media segments (0027; 0035); and

metadata is associated with the one or more media segments (0027; 0006);

in response to the user selecting the at least one customizable advertisement campaign, presenting options associated with the at least one customizable advertisement campaign to the user on the website (0010; 0011; 0039)

assembling a completed commercial, wherein the assembling comprises correlating the selected options to the metadata associated with the one or more media segments, retrieving at least one media segment using the metadata, and inserting the retrieved media segment into the customizable advertisement campaign (0027; 0036);

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presenting a list of content providers on the website, wherein each content provider is selectable by the user (0011);

in response to user selecting at least one content provider, presenting delivery options that correspond to the completed commercial to the user, wherein the delivery options include at least one of a delivery format, a delivery address, playback options, and a chargeback number (0030);

in response to receiving a request from the user to order the completed commercial, transmitting the completed commercial to at least one content provider in accordance with the delivery options selected by the user (0007; 0013).

Headings does not specifically teach presenting a preview of the completed commercial on the website prior to delivering the completed commercial to the audience.

White teaches a method and system for designing customized advertisements by using digital media assets, wherein the compiled advertisements are previewed prior to delivering to the audience (0026).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Headings to include presenting a preview of the completed commercial on the website prior to delivering the completed commercial to the audience, as disclosed in White, because it would advantageously allow to edit the compiled advertisement to adjust the content to last minute changes, as specifically stated in White.

Headings also teaches:

Claim 2. The method of claim 1, wherein the plurality of advertisement campaigns includes at least one non-customizable advertisement campaign (Fig. 3; 0035).

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Claims 3-5. Said method, wherein the completed commercial is delivered to the local content provider in a first format (tape), and wherein the preview is presented in a second format (the Internet) (0029; 0030; 0033).

Claim 6. White teaches a method and system for designing customized advertisements by using digital media assets, wherein the compiled advertisements are previewed prior to delivering to the audience (0026).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Headings to include presenting a preview of the completed commercial on the website prior to delivering the completed commercial to the audience, as disclosed in White, because it would advantageously allow to edit the compiled advertisement to adjust the content to last minute changes, as specifically stated in White.

Headings also teaches:

Claim 7. The method of claim 1, further comprising: receiving delivery information for the completed commercial; receiving playback rules for the completed commercial; and transmitting the completed commercial and the playback rules to the at least one content provider in accordance with the delivery information (0007; 0013).

Claim 8. The method of claim 7, wherein the playback rules comprise at least one of: a transmission time, a transmission date, a delivery location, and offers relating to the completed commercial (0033).

Claim 10. The method of claim 1, further comprising: determining whether the at least one local content provider transmitted the completed commercial in accordance with the playback rules; and preventing the at least one local content provider from transmitting the completed commercial to an audience in

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response to determining that the at least one local content provider has not complied with the playback rules (contracted items) (0007).

Claims 11 and 13. The method of claim 1, further comprising providing the user with targeting options for the completed commercial, wherein the targeting options include at least one of a delivery format, a delivery address, playback options, and a chargeback number (0033).

Claim 12. The method of claim 11, wherein the delivery format is one of a videotape, a DVD, a CD, a high definition format, a standard definition format, an MPEG-2 format, an MPEG-4 format, a media format, and a media resolution (0029; 0030; 0033).

### ***Response to Arguments***

Applicant's arguments filed 07/06/2009 have been fully considered but they are not persuasive.

Applicant argues: "it is noted that the body of the rejection refers to claims 1, 4, 5, 6, 11, and 13-16 as also rejected. The remainder of the rejection does not reference those claims, however, and as some of those claims are actually withdrawn from consideration in the present application, Applicants consider the reference to be a typographical error. If the rejection was, in fact, intended to apply to any of claims 1, 4, 5, 6, 11, and 13-16, Applicants respectfully request clarification of the rejection."

In response to the Applicant's argument it is noted that last Office action of 12/05/2008 states: Claims 1-23 are currently pending in the application; Claims 9, 14-21, and 23 have been withdrawn from consideration. The remaining Claims 1-8, 10-13, and 22 have been addressed in the body of the rejection.



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Accordingly, all Claims have been referenced and there is no error regarding this matter.

Applicant argues that Headings is not concerned with creating commercials at all.

In response to this argument it is noted that Headings explicitly teaches creating and distributing commercials (See: [0006]; [0027]; [0033]; [0040]).

Applicant argues that White does not describe allowing a user to select a customizable advertisement campaign which includes a plurality of media slots, where each media slot is configured to receive one or more media segments.

In response to this argument it is noted that White was applied to disclose presenting a preview of the completed commercial on the website prior to delivering the completed commercial to the audience (See a discussion above).

Applicant argues that White does not teach or suggest that "in response to the user selecting the at least one customizable advertisement campaign, presenting options associated with the at least one customizable advertisement campaign to the user on the website", and that "metadata is associated with the one or more media segments," or "assembling a completed commercial, wherein the assembling comprises correlating the selected options to the metadata associated with the one or more media segments, retrieving at least one media segment using the metadata, and inserting the retrieved media segment into the customizable advertisement campaign."

In response to this argument it is noted that White was applied to disclose presenting a preview of the completed commercial on the website prior to delivering the completed commercial to the audience. The recited features are disclosed in Headings (See a discussion above). To this end Examiner points out that applicant's arguments are directed against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the proposed combination fails to teach "presenting a plurality of advertisement campaigns to the user on the website,"

In response to this argument it is noted that Headings explicitly teaches accessing a provider's website [0039].

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/  
Primary Examiner, Art Unit 3628